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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,065	03/30/2000	MARC DOLATKHANI	BIF103705/US	3112
7590 02/09/2006 YOUNG & THOMPSON 745 SOUTH 23RD STREET SECOND FLOOR ARLINGTON, VA 22202			EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/486,065

Applicant(s)

DOLATKHANI ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-33, 38, 39, 42, 43, 64, 68 and 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-33, 38, 39, 42, 43, 64, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-23,27,28,31,32,68,69 are rejected under 35 U.S.C. 102(b) as being anticipated by Osamu (JP 5269191). Osamu discloses that monomers can be polymerized to form an intraocular lens having a rigid part and flexible part, pages 2,3. Fig. 1 shows an optic part and a haptic part. Osamu discloses (paragraph 10) that reaction functions can be used. Please note that the method of making the lens and the functional language carries no weight in the absence of any distinguishing structure. Additionally, because the Patent & Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed invention or subject matter is unobvious, the examiner properly shifts the burden to Applicants to show that unobvious differences exist, *Ex parte Phillips*, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93). The claims are directed to a lens comprising a flexible material and a rigid material, the prior art discloses the lens having both a flexible and rigid material.

Claims 23,33,68,69 are rejected under 35 U.S.C. 102(e) as being anticipated by Benz et al. (6267784). Benz discloses the lens is made of a flexible material and a rigid material, col. 3, lines 26,41-43. Benz also disclose chemically modifying the material via polymerization, col. 4, lines 62-67. Benz also discloses reaction functions can be used to structurally modify the material having at least one

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reactive compound, col. 5, lines 6,7,36,37. Please note that the method of making the lens and the functional language carries no weight in the absence of any distinguishing structure. Additionally, because the Patent & Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed invention or subject matter is unobvious, the examiner properly shifts the burden to Applicants to show that unobvious differences exist, *Ex parte Phillips*, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93). The claims are directed to a lens comprising a flexible material and a rigid material, the prior art discloses the lens having both a flexible and rigid material.

***Claim Rejections - 35 U.S.C. § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benz et al. '784 in view of Freeman et al. (5693095). Benz et al. is explained supra. Benz does disclose the polymer functional agent ethylene glycol dimethacrylate is used with the lens material, col. 5, lines 38,39. However, Benz does not disclose the use of the polyfunctional agent diethylene glycol dimethacrylate. Freeman et al. teach the use of diethylene glycol dimethacrylate for crosslinking copolymers, col. 3, lines 3-15. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an alternative crosslinking agent such as diethylene glycol dimethacrylate as taught by Freeman for crosslinking the lens material of Benz to double the effect on the degree of material crosslinked.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benz et al. '784 in view of Bos et al. (5762836). Benz is explained supra. However, Benz fails to disclose the polymer for the lens is polydimethylsiloxane. Bos et al. also disclose that polymer materials, such as polydimethylsiloxanes are suitable for the intraocular lens and can effect the refractive index of the lens material, col. 12, lines 32-36. It would have been obvious to one of ordinary skill in the art to use polydimethylsiloxane for the polymer as taught by Bos et al. in the lens of Benz such that it provides a refractive index suitable for the patient.

Claims 24,29,30,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu (JP 5269191) in view of Vanderbilt '506. Osamu is explained above. Osamu does disclose the copolymer PMMA is used and crosslinked to form the lens material. However, Osamu fails to disclose a copolymer such as a MMA is crosslinked. Vanderbilt teaches (col.7, lines 61-68, col. 8, lines 1-12) that a "zone" can be established to join the two parts of rigid material and flexible material. Vanderbilt also teaches that PMMA is a lens material (col. 7, lines 65,66) and that MMA polymers are crosslinked, example II of col. 9. Vanderbilt does disclose that crosslinking agents or functional agents are added in the materials, col. 4, lines 12-15. It would have been obvious to one of ordinary skill in the art to use other random MMA polymers and crosslink and also form zones as taught by Vanderbilt with the lens of Osamu such that a more structural lens is formed.

Claims 38,39,42,43,64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benz '784 in view of Wang et al. (6011082). Benz is explained supra. However, Benz does not disclose the agent used in crosslinking as polyfunctional. Wang teaches that polyfunctional monomers can be used in crosslinking col. 3, lines 15-19. Wang et al. teach to use a coupling agent in the polymerization process of copolymers to provide a surface modification with long-term stability. Wang also teaches that the reaction is done with a polyfunctional agent, col. 5, lines 1-7. It would have been obvious to one of ordinary skill in the art to use a polyfunctional agent

as taught by Wang in the modification of the Benz material to stabilize it. As a result this will enhance the longevity of the prosthesis.

### ***Response to Arguments***

Applicant's arguments filed 11/16/05 have been fully considered but they are not persuasive. Applicant argues that Benz does not disclose the lens has been made the same way the claimed invention has. Applicant also states the Osamu lens is different with respect to some physical properties in the lens materials resulting from different methods of making according to the Applicant. Physical properties cannot be distinguished by Examiners because the Patent & Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed invention or subject matter is unobvious, and the examiner properly shifts the burden to Applicants to show that unobvious differences exist, *Ex parte Phillips*, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (571) 272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**  
*Brian E. Pellegrino*